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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,321	08/20/2003	Irina Travkina	CR50U-US	6649
60723	7590	12/14/2007	EXAMINER	
AVON PRODUCTS, INC.			VENKAT, JYOTHSNA A	
AVON PLACE			ART UNIT	PAPER NUMBER
SUFFERN, NY 10901			1615	
			MAIL DATE	DELIVERY MODE
			12/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/644,321

### Applicant(s)

TRAVKINA ET AL.

### Examiner

JYOTHSNA A. VENKAT Ph. D

### Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-18, 22-28 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-18, 22-27, 28, and 30-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/2/07 has been entered.

Claims 1, 27 and 29 have been cancelled and claim 38 has been added as per applicant's amendment dated 10/2/07. Claims 2-18, 22-27, 28, and 30-38 are pending in the application and the status of the application is as follows:

### *Claim Rejections - 35 USC § 112*

Claims 2-18, 22-27, 28, and 30-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

This is a "written description" rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. *Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the "written description" inquiry is "*whatever is now claimed*" (see page 1117).

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). In *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of species falling within the scope of the claimed genus. At section B (1), the court states "An adequate written description of a DNA ... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention". Hence, an adequate written description of the ingredients requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984). Accordingly, describing a mascara composition or method of increasing the resistance of the hair fibers of eyelashes having a mascara base and the mascara base has wax-like material that is natural or synthetic resin and a keratin conditioning agent which is "other source of amino acids" in the absence of knowledge as to what the material consists of or the source of the material is not a description of the material

or a method of making the material. Applicant fails to adequately describe “natural or synthetic resin”. Natural resin is a plant exudate. It can be any of the following:

- sandarac, sandarach — a brittle and faintly aromatic translucent resin
- guaiacum —resin from the lignum vitae tree
- storax — a vanilla-scented resin from various trees of the genus *Styrax*
- scammony — resin from the root of *Convolvulus scammonia*
- acaroid resin, accaroid resin, accroides, accroides resin, accroides gum, gum accroides — an alcohol-soluble resin from Australian trees
- anime, gum anime — any of various resins or oleoresins
- asafetida — the gum resin of various plants
- camphor — a resin obtained from the camphor tree
- amber — a hard yellowish to brownish translucent fossil resin
- copal — a brittle aromatic resin
- dammar, gum dammar, damar, dammar resin — any of various hard resins from trees of the family *Dipterocarpaceae* and of the genus *Agathis*
- colophony — translucent brittle substance produced from pine oleoresin
- mastic — an aromatic exudate from the mastic tree
- oleoresin — a naturally occurring mixture of a resin and an essential oil obtained from certain plants
- gum resin — a mixture of resin and gum
- wood tar — any tar obtained by the destructive distillation of wood
- 

Specification fails to describe one single species belonging to any natural resin let alone all the natural resins. The same is true for **synthetic resin**. Synthetic resin by definition is a resin having a polymeric structure. Synthetic resin can be any one of the following:

acrylate resin, acrylic resin

polyethylene, polythene allyl resin

resin, rosin

urea-formaldehyde resin

alkyd resin

phenolic resin, melamine resin -

polyester

polyvinyl resin

Specification fails to describe one resin belonging to “synthetic resin”.

The same is true for “other sources of amino acids”. Specification fails to describe the “other source of amino acids. The same is true for “resin derivatives”. Resin derivative is described in the specification as rubber or latex or rosin ester or hydrogenated rosin ester or polyamide resins or rubber or latex. Rubber can be natural rubber or synthetic rubber.

**Natural rubber** is an elastic hydrocarbon polymer that occurs as a milky colloidal suspension Or latex, in the sap of some plants. Rubber can also be synthesized. There is no specific description for rubber. Same is true for latex. Latex is a polymer that occurs in the sap of some plants. The specification fails to describe esters under “rosinate esters or hydrogenated rosin ester esters. What is the nature of these esters? What is the structure of these rosin ester esters?

Specification fails to describe “polyamide resins”. There is no structure for these polyamide resins. Is it simple polyamide resins or ester terminated polyamide resins or amide terminated polyamide resins?

The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. However, the present claim encompasses numerous species that are not further described. One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to “natural resin or synthetic resin or resin derivatives or other source of amino acids”.

The courts have stated:

“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. *Lockwood v. American Airline, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gosteli* 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“ [T] he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus an applicant complies with written description requirement “ by describing the invention, with all its claimed limitation, not that which makes it obvious,” and by using “ such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood v. American Airline, Inc.*, 107 F.3d at 1572, 41 USPQ2d at 1966; *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder* 736 F.2d 1516, 1521, 222 USPQ 369, 372-373 (Fed. Cir. 1984). Accordingly, it is deemed that the specification fails to provide adequate written description for the genus “ natural resin or synthetic resin or resin derivatives ( polyamide resins, rubber , latex, rosinates esters or



hydrogenated rosin esters belonging to wax-like material and other source of amino acids belonging to conditioning agent ” and does not reasonably convey to one skilled in the relevant art the inventor(s), at the time the application was filed has possession of the entire scope of the invention drawn to mascara composition or method of increasing the resistance of hair fibers of eyelashes to breaking using the mascara composition having a wax-like material.

Claims 2-18, 22-27, 28, and 30-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the specification for “up to about 2.5% “of emulsifier. The support is for “less than”

Claims 2-3, 35, 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions “other source of amino acids “, “natural resin and synthetic resin” is without metes and bounds. Recourse to the specification does not define the compound suitable in all of three categories. See written description above.

Deletion of second occurrence of “mascara” is suggested in claim 35.

Regarding claims 37-38, the phrase “the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “the like”), thereby rendering the scope of the claim(s) unascertainable.



***Claim Rejections - 35 USC § 102***

Claims 35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,264,933 ('933).

See examples 1-4. "Wheat protein hydrolysate" reads on the claimed keratin-conditioning agent. All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to "mascara compositions" and all the examples has keratin-conditioning agent "hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

*Products of identical chemical composition can not have mutually exclusive properties."*

*A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).*

***Response to Arguments***

Applicant's arguments filed 10/2/07 have been fully considered but they are not persuasive.

Applicants argue that claims have been amended to recite an oil-in water emulsion comprised of oil phase and an aqueous phase.

In response, claims 35-36 are independent claims and they do not recite the limitations of claims 37 or 38.

Claims 35-36- are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,274,131 ('131).

See examples 1-2 and 6-8. "Wheat protein hydrolysate" reads on the claimed keratin-conditioning agent. Panthenol in example 8 reads on claimed "emollient/moisturizing agent". All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to "mascara compositions" and all the examples has keratin-conditioning agent "hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

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#### ***Response to Arguments***

Applicant's arguments filed 10/2/07 have been fully considered but they are not persuasive.

Applicantst argue that patent '131 does not disclose having the claimed keratin conditioning agent having lower limit of 0.5%.

In response the claims do not recite any percentage for keratin conditioning agent.

Claims 35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,053,221 ('221)

See examples 1-3. "Crosilk liquid and Crosilk" read on the claimed keratin conditioning agent, which is silk amino acids and mixtures thereof". Panthenol in example 8 reads on claimed "emollient/moisturizing agent". All other ingredients comprise mascara base. Since the base and keratin conditioning agent is same, the composition would be expected to have the claimed viscosity measured by Brookfield Viscometer at 77° F. All the examples are drawn to "mascara compositions" and all the examples has keratin-conditioning agent "hydrolyzed vegetable protein" and therefore the compositions are also useful for increasing the resistance of hair fibers of eyelashes to breaking.

*Products of identical chemical composition can not have mutually exclusive properties."*

*A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).*

#### ***Response to Arguments***

Applicant's arguments filed 10/2/07 have been fully considered but they are not persuasive.

Applicantst argue that the claimed invention is water-in oil emulsion and patent '221 does not include oil in the composition or soft waxes.

In response, claims are independent claims and they do not recite oil-in-water emulsion or soft waxes.

Application is in condition for allowance subjecting to 1) cancellation of claims 35-36  
2) deleting " other amino acids", deleting wax like material and deleting natural or  
synthetic resin or resin derivative and inserting " shellac wax" 3) deleting " up to" and inserting "  
less than" at all occurrences.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is  
571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday  
off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number  
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent  
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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/JYOTHSNA A. VENKAT/ Ph. D**  
**Primary Examiner**  
**Art Unit 1615**